

REMARKS

Claims 1-4 and 6-7 are pending in this application. By this Amendment, Claim 1 is amended. Applicants respectfully submit that no new matter is presented herein.

Telephonic Interview

Applicants respectfully acknowledge and appreciate the courtesies extended to Applicants' representative by Examiner Mercado during the telephonic interview conducted April 11, 2006, the points of which are incorporated herein.

Entry of Response Proper

Entry of this Amendment is proper under 37 C.F.R. §1.116 since the amendments: (a) place the application in condition for allowance for the reasons discussed herein; (b) do not raise any new issues requiring further search and/or consideration on the part of the Examiner as the amendments to Claim 1 merely positively recite a feature, i.e., "the gap," that was inherently recited therein and previously considered by the Examiner; (c) satisfy a requirement of form asserted in the previous Office Action; (d) do not present any additional claims without canceling a corresponding number of finally rejected claims; and (e) place the application in better form for appeal, should an appeal be necessary. The Amendment is necessary and was not earlier presented because it is made in response to objections raised in the Final Rejection. Entry of the Amendment is thus respectfully requested.

Withdrawal of Rejections

Applicants respectfully acknowledge the withdrawal of the following rejections by the Office Action: 1) Claim 10 was rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,153,326 to Matsukawa et al. (Matsukawa); 2) Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,464,700 to Steck et al. (Steck) in view of Matsukawa; and 3) Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Steck in view of Matsukawa.

Claim Rejections – 35 U.S.C. §112

Claims 1-4 and 6-7 are rejected under 35 U.S.C. § 112, first paragraph. Applicants respectfully traverse the rejection.

As was pointed out during the telephonic interview conducted April 11, 2006, Applicants respectfully submit that the originally filed application provides adequate support for the range recited by Claims 1 and 7. As was identified during the interview, Applicants submit the paragraph bridging pages 41-42 of the Specification, the Table 7 on page 60, and the associated discussion following Table 7 provides clear support for the recited range. In view of the above, Applicants respectfully request withdrawal of the rejection.

Claim 7

In view of the above-discussed amendment to Claim 7, which is responsive to the rejection under 35 U.S.C. §112, first paragraph, and the withdrawal of the only prior art based rejection of Claim 7, Applicants respectfully submit that Claim 7 is believed to be in condition for allowance

Claim Rejections – 35 U.S.C. §103

Claims 1-4 and 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,464,700 to Steck et al. (Steck) in view of Matsukawa. Applicants respectfully traverse the rejection.

The Office Action notes that in the Response of November 16, 2005, Applicants argued that Claim 1 recites a polymer electrolyte fuel cell having the structural feature of a seal . . . to retain the gap between the corresponding separator and membrane electrode assembly upon sealing. The Office Action further notes that the Applicants then argued that the asserted prior art fails to teach or at least suggest the structural feature of the gap between the elements being retained upon sealing. As such, the Office Action summarizes Applicants' assertions traversing the rejection are based on the gap being a requisite feature of the claimed fuel cell. However, the Office Action points out that Claim 1 does not positively recite the gap as a required structural feature of the fuel cell. That is, Claim 1 inherently recites the gap as a structural feature and is a part of a product-by-process feature.

Applicants note that it is well established that in such product-by-process claims, the determination of patentability is based on the product itself. The patentability of the product does not depend on the method of production. If the product of the product-by-process claim is the same as or obvious from a product of prior art, the claim is unpatentable even though the product was made by a different process. See M.P.E.P. §2113 and *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). However, it is also well settled that the structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior

art especially . . . where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. See M.P.E.P. §2113 and *In re Gamero*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979).

In this regard, Applicants have amended Claim 1 to positively recite the gap between the corresponding separator and membrane electrode assembly as a structural feature of the fuel cell. Therefore, as was agreed upon during the interview, Applicants respectfully submit the gap between the separator and membrane electrode assembly is a structural feature that must be taught or at least suggested by Steck and/or Matsukawa in order to establish *prima facie* obviousness of the rejected claims, as is required by M.P.E.P. §2143.03.

However, as was also agreed upon during the interview, Steck and/or Matsukawa each fail to teach or suggest the structural feature of the gap being formed between a separator and membrane electrode assembly that is retained upon sealing. See Figure 4 of Steck.

For at least these reasons, Applicants respectfully assert that Matsukawa fails to overcome or otherwise address this deficiency of Steck.

To establish *prima facie* obviousness of a rejected claim, each and every feature of the rejected claim must be taught or at least suggested by the applied art of record. See M.P.E.P. §2143.03. As explained above, Steck and Matsukawa, alone or in combination, do not teach or suggest the “gap” being retained between the separator and membrane electrode assembly. Claim 1 of the instant application recites such a feature.

Therefore, for all of the above-discussed reasons, Applicants respectfully submit Claim 1 is not rendered obvious in view of Steck and Matsukawa and should be deemed allowable.

Claims 2-4 and 6 depend from Claim 1. It is respectfully submitted that these dependent claims be deemed allowable for at least the same reasons Claim 1 is allowable, as well as for the additional subject matter recited therein.

Withdrawal of the rejection is respectfully requested.

Conclusion

In view of the foregoing, reconsideration of the application, withdrawal of the outstanding rejections, allowance of Claims 1-4 and 6-7, and the prompt issuance of a Notice of Allowability are respectfully solicited.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, **referencing docket number 106145-00029.**

Respectfully submitted,
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